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OFFICE OF PETITIONS

In re Application of :
Scarantino, Nagle, Kim, Ufer, : DECISION ON PETITION
Fiering, and Kermani :
Application No. 10/089,483 :
Filed: 17 September, 2002 :
Atty Docket No. 9099-2IP :

This is a decision on the twice renewed petition under 37 CFR 1.183 and 1.47(a), filed on 31 March, 2006, which is being treated as (1) a petition under 37 CFR 1.48(a) to amend the inventive entity be the addition of Stefan Ufer, Jason Fiering, and Bahram Ghaffarzadeh Kermani; (2) a petition under 37 CFR 1.183 requesting waiver of 1.48(a)(2) which requires a statement from the persons being added, and (3) a petition under 37 CFR 1.47(a), which requires an oath or declaration signed by all of the inventors.

The petitions are GRANTED.

On 17 September, 2002, the application was filed with a declaration naming Charles W. Scarantino, H. Troy Nagle, and Chang-Soo Kim as joint inventors.

On 4 October, 2005, a non-final Office action was mailed, setting a three (3) month shortened statutory period for reply.

A petition under 37 CFR 1.47(a) and 1.48(a) was filed on 7 October, 2005. The petition was dismissed on 25 October, 2005. A renewed petition was filed on 23 December, 2005, and was dismissed on 30 January, 2006. The present second renewed petition was filed on 31 March, 2006 (certificate of mailing date 29 March, 2006). Petitioners seek to add Ufer, Fiering, and Kermani as joint inventors. Petitioners further state that Ufer has refused to sign the statement of lack of deceptive intent

required by 37 CFR 1.48(a) and the declaration required by 37 CFR 1.63 and 1.67. The petition is accompanied by consent of the assignee(s), statements of lack of deceptive intent signed by Fiering and Kermani, and a declaration naming Scarantino, Nagle, Kim, Ufer, Fiering, and Kermani as the inventive entity, signed by all joint inventors except Ufer on behalf of themselves and inventor Ufer.

Petitioners assert that a copy of the application was sent to Ufer on 21 December, 2005, but that he has failed to sign and return the declaration. Petitioners further state, in the present renewed petition, that Ufer has failed to sign and return the declaration.

Petitions Under 1.183 and 1.48(a).

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

(1) a petition including a statement from each person being added and each person being deleted as an inventor that the error occurred without deceptive intention on his or her part;

(2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43, or 1.47;

(3) the fee set forth in 37 CFR 1.17(i); and

(4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment

As a result of papers filed on 31 March, 2006, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and, accordingly, this application has been corrected in compliance with 37 CFR 1.48(a)(2).

In view of the efforts recounted in the petition to obtain the signature of Stefan Ufer, it is agreed that justice would be served by waiving the requirement for his signature on the statement of lack of deceptive intent required by 37 CFR 1.48(a).

The inventorship of this application has been changed by the addition of: Stefan Ufer, Raleigh, North Carolina, Jason Fiering, Boston, Massachusetts, and Bahram Ghaffarzadeh Kermani, San Diego, California.

Office PALM records have been corrected to reflect the correct inventorship of the application. A corrected Filing Receipt is enclosed for petitioner's convenience.

Petition Under 37 CFR 1.47(a).

Petitioners have shown that the non-signing inventor could not be located despite diligent efforts. Specifically, petitioners have established although a copy of the application papers was sent to the last known address of the non-signing inventor, the inventor has failed to sign and return the declaration.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the Declaration. Notice of the filing of this application will also be published in the *Official Gazette*.

The application is being referred to Technology Center Art Unit 3735 for further processing.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



Douglas I. Wood
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Office of Petitions

Encl: Corrected Filing Receipt